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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,061	10/31/2001	Frederick W. Giacobbe	25184-P033US / S5648	6704

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EXAMINER

RAGONESE, ANDREA M

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 02/10/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,061

Applicant(s)

GIACOBBE, FREDERICK W.

Examiner

Andrea M. Ragonese

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-76 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I (**claims 1-61**) in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the Examiner improperly required the restriction and should therefore withdraw the same and examine all of the claims. This argument is found persuasive and the previous restriction requirement has been withdrawn. However, a new restriction requirement is deemed proper and has been issued.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claims 1-61**, drawn to a heat transfer fluid mixture, classified in class 252, subclass 71.
 - II. **Claims 62-66**, drawn to methods of using a heat transfer fluid mixture, classified in class 34.
 - III. **Claims 67-76**, drawn to a method of making a heat transfer fluid mixture, classified in classes 252, subclass 73.
3. The inventions are distinct from the other because of the following reasons: Inventions I, III and II are related as product, process of making and process of using the product, respectively. Since claims to all three categories – product, process of making and process of use – are included in this national application, a three-way requirement for restriction can be made. The inventions are distinct if it can be shown that the process of making is distinct from the product. See MPEP § 806.05(i)). In this case, the independently claimed process of making the product is distinct from the

Art Unit: 3743

independently claimed product because the process does not necessarily utilize products composed of gases with the same molecular weight relationship as that of the gases composed by the claimed product.

4. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and the search required for Group I is not required for Group II or Group III, restriction for examination purposes as indicated is proper.

5. **In the case that the applicant elects the examination of Group II, an *additional* restriction shall be imposed and election required.** Restriction to one of the following inventions is required under 35 U.S.C. 121:

II-A. **Claims 62-64**, drawn to a method of improving cooling of an object with a gas mixture, classified in class 34, subclass 428.

II-B. **Claims 65-66**, drawn to a method of improving heating of an object with a gas mixture, classified in class 34, subclass 487.

6. The inventions are distinct, each from the other because of the following reasons: Inventions II-A and II-B are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II-A has separate utility such as a method for cooling an object while invention II-B has a separate utility such as a method for heating an object. See MPEP § 806.05(d).

Art Unit: 3743

7. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and the search required for Group II-B is not required for Group II-A, restriction for examination purposes as indicated is proper.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese** whose telephone number is (703) **306-4055**. The examiner can normally be reached on Monday through Thursday from 8 am until 4 pm ET.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

amr
February 5, 2004

Henry Bennett
Supervisory Patent Examiner
Group 3700